

**Remarks / Arguments**

Reconsideration of the present invention in view of the above amendments and the following remarks is respectfully requested.

**Status of the claims:**

Claims 19-28 are pending and stand rejected. Claims 1-18 and 29 have been withdrawn from consideration pursuant to a restriction requirement. Claims 19 and 28 have been amended herein.

Claims 19-28 are rejected under 35 U.S.C. § 102(e) as being unpatentable over U. S. Pat. App. Pub. No. 2002/0077259 ("Skee").

Claims 19-28 are rejected under 35 U.S.C. § 102(b) as being unpatentable over EP 1115035 ("Lassila '035").

Claims 19-28 are rejected under 35 U.S.C. § 102(b) as being unpatentable over U. S. Pat. No. 4,833,067 ("Tanaka") or U. S. Pat. No. 5,756,267 ("Matsuda").

Claims 19-28 are rejected under 35 U.S.C. § 102(b) as being unpatentable over U. S. Pat. No. 5,977,041 ("Honda").

Claims 19-28 are rejected under 35 U.S.C. § 102(b) as being unpatentable over U. S. Pat. No. 6,027,854 ("Nishi et al.").

Claims 19-28 are rejected under 35 U.S.C. § 102(e) as being unpatentable over U. S. Pat. No. 6,313,182 ("Lassila '182").

These issues will be treated in turn below.

**Restriction Requirement:**

Applicant hereby affirms its prior election with traverse of Group II, claims 19-28, reserving its right under 35 USC § 121 to file a divisional application for the non-elected claims.

Applicant respectfully traverses the restriction requirement on the following basis. A restriction requirement is proper only where there is a serious burden on the Patent Office to examine all of the claims in a single application, even when it appears that appropriate reasons exist for a restriction requirement. MPEP §803. Applicant respectfully submits that

there would be no serious burden on the Patent Office to examine in this application all of the present claims because the subject matter of the claims is sufficiently related such that a search of the claims in any one Group would encompass a search for the subject matter of the other Group. Thus, the restriction requirement is improper and should not be maintained.

Reconsideration and withdrawal of the restriction requirement are respectfully requested.

**The Claim Amendments:**

Claims 19 and 28 are amended herein to recite the limitation "provided that the process solution is substantially free of one or more compounds selected from a base, an organic acid, a phenolic compound, an inorganic compound selected from a mineral ore and a pigment, and an organic compound selected from a pigment, a polymerizable monomer, an oligomeric resin, a polymeric resin, a macromolecule, a detergent, a detergent, a herbicide, an insecticide, or a plant growth modifying agent".

Applicant respectfully requests that the Examiner enter the above claim amendments.

**The § 102 Rejections:**

Applicant traverses the 102(b) and 102(e) rejections of claim 19-28 in view of the cited prior art. As mentioned previously, newly amended claims 19 and 28, and claims 20-27 which depend therefrom, recite a process solution that is "substantially free of one or more compounds selected from a base, an organic acid, a phenolic compound, an inorganic compound selected from a mineral ore and a pigment, and an organic compound selected from a pigment, a polymerizable monomer, an oligomeric resin, a polymeric resin, a macromolecule, a detergent, a detergent, a herbicide, an insecticide, or a plant growth modifying agent."

None of the cited prior art discloses all of the required elements of newly amended claims 19-28. Skee describes an aqueous cleaning solution that contains one or more metal ion-free bases and optionally an acetylenic diol surfactant. Lasilla '035 discloses an alkaline, aqueous developer solution that includes the base tetramethylammonium hydroxide (TMAH), a phenolic compound, and an acetylenic diol surfactant (see Lasilla at page 11, lines 21-57). Like Lasilla, Tanaka and Matsuda each disclose basic, aqueous developer solutions that may include TMAH or a quaternary ammonium base and a surfactant or surface active agent, respectively (see Tanaka, for example, at col. 3, lines 19-27; col. 3, lines 36-50; see

Matsuda, for example, at col. 2, lines 21-32). Honda discloses an aqueous 'post-strip' rinsing solution that includes at least one water soluble organic acid and at least one water-soluble surface-active agent (see Honda, for example, at col. 2, lines 51-58; col. 5; lines 45-53; col. 6, lines 11-24). Nishi describes a chemically amplified positive resist composition that comprises an organic solvent, a base resin that is a phenolic-compound, a photoacid generator, and an acetylene alcohol derivative. Lastly, Lasilla '182 describes a water-based composition that contains an inorganic compound selected from a mineral ore and a pigment and/or an organic compound selected from a pigment, a polymerizable monomer, an oligomeric resin, a polymeric resin, a macromolecule, a detergent, a herbicide, an insecticide, or a plant growth modifying agent in addition to "an effective amount" of an acetylenic diol surfactant. Accordingly, reconsideration and withdrawal of the rejections of newly amended claims 19 and 28 and 20-27 which depend therefrom under 35 U.S.C. § 102(b) and § 102(e) over the cited prior art is respectfully requested.

#### SUMMARY

For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned Attorney at the telephone number listed below.

Respectfully submitted,



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